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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,697

05/09/2006

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852.0103.U1(US)

3700

29683 7590 06/01/2009
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EXAMINER

GALKA, LAWRENCE STEFAN

ART UNIT

PAPER NUMBER

4136

MAIL DATE

DELIVERY MODE

06/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,697	Applicant(s) STRAWN ET AL.	
	Examiner LAWRENCE GALKA	Art Unit 4136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the Preliminary Amendment filed on May 9, 2006, claims 1-30 are pending.

Drawings

2. The drawings are objected to because the “chamfered portion 34” should be recited in Fig. 3A and 3B. In addition, the reference number “34” in Figs. 4A-4C should be pointed to the chamfered portion and not the channel portion. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: The term --This application is a 35 USC 371 National Stage entry of PCT/GB03/04978, filed on November 17, 2003, and the content of which is herein incorporating by reference.-- should be recited page 1, line 4, so as to clarify the status. In addition, the terms “surface 8.. The aperture” (page 4, line 27), “input device 2,” (page 6, line 8) and “interconnecting channel is” (page 7, line 29) should be respectively recited as --surface 8. The aperture--, --input device 10-- and --interconnecting channel 37 is--, so as to overcome the typographic errors. Further, the reference number “34” is directed to the “chamfered portion 34” (page 5 of the specification) but also is directed to the “channel 34” (pages 7 and 8 of the specification), it is suggested that the term “channel 34” should be recited as --channel--, so as to clarify the confusion. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14, 22-24 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-14, the sole claimed structural element of the user input device cannot perform the function for the portable electronic gaming device as claimed.

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Regarding claims 7-9, 13 and 22-24, the antecedent basis for “its extended configuration” (as per claims 7-9 and 22-24) and “its retracted configuration” (as per claims 7, 9, 22 and 24) are lacking. In addition, the terms “biasing the support” (as per claim 7), “its extended configuration” (as per claims 7-9 and 22-24), “its retracted configuration” (as per claims 7, 9, 22 and 24) and “electronic device” (as per claim 13) should be respectively recited as --biasing the extendible support--, --the second configuration--, --the first configuration-- and --electronic gaming device--, so as to clarify the confusion.

Regarding claims 14 and 29, the recitation therein is unclear and confusing. It is not understood as to whether these claims are independent claims or dependency claims. If they are independent claims, all the claimed structural elements must be clearly set forth therein. If they are dependent claims, then the preamble is inconsistent with their respective parent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 10, 11, 14, 16, 25 and 26, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Lektion et al (US Pat. No. 6,198,472 B1).

Regarding claim 1, Figs. 4B and 5B of Lektion et al teaches *a portable electronic gaming device comprising: a user input device comprising an extendible support (105) having at a first end a tactile member (108) for user actuation and mounted at a second end for pivotal movement*

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(col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein in the second configuration the user input device is operable as a joystick game controller* (col. 4 lines 58-67; col. 6, lines 34-39 and 60-63).

Regarding claim 14, Figs. 4B and 5B of Lektion et al disclose *a user input device comprising an extendible support (105) having at a first end a tactile member (108) for user actuation and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein in the second configuration the user input device is operable as a joystick game controller* (col. 4 lines 58-67; col. 6, lines 34-39 and 60-63).

Regarding claim 16, 4B and 5B of Lektion et al teaches *a user input device comprising an extendible support (105) having at a first end a tactile member for user actuation (108) and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein the user input device functions as an input device in both first and second operational configurations* (col. 4, lines 30-35).

Regarding claims 10 and 25, Lektion et al discloses that *the tactile member is raised approximately 3-8 mm in the second configuration compared to the first configuration* (from col. 4, line 66 to col. 5, line 5).

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Regarding claims 11 and 26, Lektion et al shows *discrimination means for discriminating the current configuration of the user input device and control means for controlling the operation of the gaming device in dependence upon said discrimination* (i.e. the circuitry that connects the pointer stick to the computer is the discriminating means as it can detect the change in position when the stick is popped upward, while the control means is the microprocessor in the computer to which the keyboard is attached; see col. 5, lines 14-18).

Regarding claim 29, 4B and 5B of Lektion et al teaches *a user input device comprising an extendible support (105) having at a first end a tactile member for user actuation (108) and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein the user input device functions as an input device in both first and second operational configurations* (col. 4, lines 30-35).

8. Claims 1-9, 14-24, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawyer (US Pat. No. 6,433,777 B1).

Regarding claim 1, Figs. 3B-3E, 4B and 4C of Sawyer shows *a user input device comprising an extendible support (316, 412) having at a first end a tactile member for user actuation (122) and mounted at a second end for pivotal movement* (from col. 5, line 66 to col. 6, line 1), *wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended, wherein in the*

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second configuration the user input device is operable as a joystick game controller (col. 5, lines 57-65).

Regarding claim 14, Figs. 3B-3E, 4B and 4C of Sawyer disclose *a user input device comprising an extendible support (316, 412) having at a first end a tactile member for user actuation (122) and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended, wherein in the second configuration the user input device is operable as a joystick game controller (col. 5, lines 57-65).*

Regarding claim 15, Figs. 3B-3E, 4B and 4C of Sawyer discloses *a user input device, for a portable electronic gaming device, comprising: an extendible support (316, 412) having at a first end a tactile member for user actuation (122) and mounted for pivotal movement (from col. 5, line 66 to col. 6, line 1) about a second end wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended, wherein in the second configuration the user input device is operable as a joystick (see Figs. 3D and 3E; col. 5, lines 57-65).*

Regarding claim 16, Figs. 3B-3E, 4B and 4C of Sawyer shows *an electronic device comprising: a user input device comprising an extendible support (316, 412) having at a first end a tactile member (122) for user actuation and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended, wherein the user input device*

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functions as an input device in both first and second operational configurations (see Figs. 3D and 3E; col. 5, lines 57-65).

Regarding claim 30, Figs. 3B-3E, 4B and 4C of Sawyer shows *a user input device, for an electronic device, comprising: an extendible support (316, 412) having at a first end a tactile member (122) for user actuation and mounted for pivotal movement* (from col. 5, line 66 to col. 6, line 1) *about a second end, wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended, wherein the user input device functions as an input device in both first and second operational configurations* (see Figs. 3D and 3E; col. 5, lines 57-65).

Regarding claims 2 and 17, Figs. 3B-3E, 4B and 4C of Sawyer discloses that the *pivotal movement of the user input device is restricted in the first configuration and the user input device pivots freely in the second configuration* (i.e. a conventional cursor control is restricted in its ability to pivot compared to a joystick; col. 5 lines 57-65).

Regarding claim 3, Sawyer teaches that *the input device functions as an input device in both first and second configurations* (col. 5, lines 57-65).

Regarding claims 4 and 18, Sawyer discloses *the input device is operable as a navigation device in the first configuration* (i.e. a conventional cursor control stick can be used to move a cursor on a computer display; col. 5, lines 57-65).

Regarding claims 5 and 20, Sawyer shows that *means for extending the extendible support in response to a first user action and for retracting the extendible support in response to a reversal of the first user action* (i.e. pushing the plunger of a ball point pen extension and retraction mechanism until it latches is a first user action and releasing the plunger is a reversal

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of the first user action in that it undoes the physical change triggered by the first user action; col. 6, lines 57-61; col. 7, lines 16-41).

Regarding claims 6 and 21, Sawyer teaches *means for extending the extendible support in response to a twisting motion applied to the tactile member about an axis of extension of the extendible support* (i.e. guides apply a force to the latch member causing it to rotate as the second segment moves between extended and collapsed positions; from col. 6, line 63 to col. 7, line 7).

Regarding claims 7 and 22, Sawyer discloses *a bias mechanism for biasing the support towards its extended configuration and a user releasable locking mechanism for retaining the extendible support in its retracted configuration* (i.e. the spring 328 is the biasing force that cause latch member to move toward extended position and the tabs 338/guides 342 are the user releasable locking mechanism; col. 7, lines 16-29).

Regarding claims 8 and 23, Sawyer shows *means for extending further comprises a user releasable locking mechanism for retaining the extendible support in its extended configuration* (I.e. the inwardly disposed rim 344 and outwardly disposed rim 365 prevent the spring from causing the two segments to separate at the furthest extent of their extension thereby retaining the extendible support in its extended configuration; col. 7, lines 8-15).

Regarding claims 9 and 24, Sawyer teaches *the means for extending further comprises a guide mechanism for guiding the extendible member between its retracted configuration and its extended configuration* (from col. 6, line 63 to col. 7, line 7).

Regarding claim 19, Figs. 3D and 3E of Sawyer shows *the input device is operable as a joystick device in the second operational configuration* (col. 5, lines 57-65).

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Regarding claim 29, Figs. 3B-3E, 4B and 4C of Sawyer teach *a user input device comprising an extendible support (316, 412) having at a first end a tactile member (122) for user actuation and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended, wherein the user input device functions as an input device in both first and second operational configurations (see Figs. 3D and 3E; col. 5, lines 57-65).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10, 11, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (US Pat. No. 6,433,777 B1) in view of Lektion et al (US Pat. No. 6,198,472 B1).

Regarding claims 10 and 25, it is noted that Sawyer does not explicitly show that *the tactile member is raised approximately 3-8 mm in the second configuration compared to the first configuration*. However, Lektion et al shows that such feature of the tactile member being raised approximately 1/4" in the second configuration compared to the first configuration (from col. 4, line 66 to col. 5, line 5) is old and well known. Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Sawyer with the feature of the tactile member being raised approximately 1/4" in the second configuration compared to the first configuration as taught by Lektion et al as both Sawyer and Lektion et al are directed to the portable electronic gaming device, so as to give clear feedback that the user had switched the input device from one mode to the other (Lektion et al: col. 4, line 65 to col. 5, line 3).

Regarding claims 11 and 26, it is noted that Sawyer does not explicitly teach *discrimination means for discriminating the current configuration of the user input device and control means for controlling the operation of the gaming device in dependence upon said discrimination*. However, Lektion et al teaches the circuitry that connects the pointer stick to the

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computer can detect the change in position when the stick is popped upward (col. 5, lines 14-18) as well as a computer system (col. 5, lines 31-37) which are the discriminating means and control means respectively. Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Sawyer with the feature of the discrimination means for discriminating the current configuration of the user input device and control means for controlling the operation of the gaming device in dependence upon said discrimination as taught by Lektion et al as both Sawyer and Lektion et al are directed to the portable electronic gaming device. Detection of the mode of the input device would allow for a distinct set of operating parameters for each configuration which would improve the control experienced by user when using the input device in either configuration.

11. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lektion et al (US Pat. No. 6,198,472 B1) or Sawyer (US Pat. No. 6,433,777 B1) in view of Oueslati et al (US Pat. No. 6,806,865 B2).

Regarding claims 12 and 27, it is noted that the teachings of Lektion et al or Sawyer do not disclose *an electronic gaming device that is pocket sized and for handheld use*. However, Oueslati et al et al teaches of a joystick on a handheld computer (from col. 1, line 63 to col. 2, line 4). Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Lektion et al or Sawyer with the features of the electronic gaming device is pocket sized and for handheld use as taught by Oueslati et al as both Lektion et al or Sawyer and Oueslati et al are directed to the portable electronic gaming device, so as to allow gaming while on public transportation or when traveling.

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12. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lektion et al (US Pat. No. 6,198,472 B1) or Sawyer (US Pat. No. 6,433,777 B1) in view of Oueslati et al (US Pat. No. 6,806,865 B2) and further in view of Peng (US Pub. No. 2003/0052861 A1).

Regarding claims 13 and 28, it is noted that that the teachings of Lektion et al or Sawyer and Oueslati et al do not disclose *an electronic gaming device further operable as a mobile cellular telephone*. However, Peng teaches a joystick on a mobile cellular telephone (¶[0015]). Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Lektion et al or Sawyer and Oueslati et al with the features of the electronic gaming device further operable as a mobile cellular telephone as taught by Peng as both Lektion et al or Sawyer, Oueslati et al and Peng are directed to the portable electronic gaming device, so as to allow gaming while on public transportation or when traveling.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Young et al. (US Pat. No. 7,129,928 B2) discloses a mobile phone with a retractable joystick.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE GALKA whose telephone number is (571) 270-1386. The examiner can normally be reached on M-Th 7:30-5, every other F 7:30-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (571) 270 1493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LSG
5/8/09

/Joe H Cheng/
Supervisory Patent Examiner
Art Unit 4136